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10/800,551	03/15/2004	Kirk P. Bumgarner	SP00-038A	9834
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CORNING INCORPORATED			EXAMINER	
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CORNING, NY 14831				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/800,551
Filing Date: March 15, 2004
Appellant(s): BUMGARNER ET AL.

SEP 13 2007

GROUP 3600

Robert L. Carlson
(Reg. No. 35,472)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 July 2007 appealing from the Office action mailed 27 December 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,027,062	Bacon et al.	02-2000
4,206,883	Isoard	06-1980

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon et al (US 6,027,062) in view of Isoard (US 4,206,883).

Bacon discloses an apparatus and method of treading a moving length of optical fiber through a component in an optical fiber draw, optical fiber winding or optical fiber testing process, comprising:

activating an aspirator 82 to obtain the optical fiber at a first location and moving the optical fiber via a positioning device 90, 92 in at least two dimensions to move the optical fiber to a second location to thread the optical fiber through a component in the optical fiber draw process.

Bacon fails to teach the positioning device being an aspirator.

Isoard teaches activating an aspirator 13 mounted on a carriage 17, to obtain the fiber at a first location 3, 4 (position I) and moving the fiber to a second location (position II) to thread the fiber through a component 7, 8 in the fiber draw process (Fig. 3, col. 4 line 58 to col. 5 line 28).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the positioning device of Bacon to include an aspirator to hold the fiber as suggested by Isoard, to hold the fiber while transferring and the fiber without causing damage to the fiber.

In regards to claim 39, Bacon as modified by Isoard teaches orienting at least a first 21, second 22, and third pulley 23 (Bacon) so that, when the aspirator 13 (Isoard) moves the fiber to the second location, the pulleys are disposed along the length of the fiber and on alternating sides of the desired fiber (Fig. 3, Bacon), and the method further comprises moving the second pulley 22 across the path of the fiber to retain the fiber in contact with the first, second, and third pulleys, thereby causing the fiber to move in a serpentine path (Fig. 4).

In regards to claims 40 and 41, Bacon as modified by Isoard teaches the aspirator 13 (positioning device) is moved to guide the fiber onto at least one guide pulley 42 by the aspirator (positioning device) guiding the fiber between or against a pair of surfaces 41 which are disposed on each side of the guide pulley, the surfaces sloping toward the guide pulley to thereby guide the fiber onto the guide pulley.

In regards to claim 42, the second location is near the spool 68.

In regards to claims 43-45, Bacon as modified by Isoard teaches engaging the fiber at a point between the aspirator and the source of fiber, and winding the engaged fiber onto the spool and is engaged by a snagger tooth located on the spool (Fig. 15C, Bacon).

In regards to claim 46-47, Bacon as modified by Isoard teaches moving the fiber into contact with a capstan 11.

In regards to claim 48, Bacon as modified by Isoard teaches orienting at least a first 21, second 22, and third pulley 23 so that, when the aspirator (positioning device) moves the fiber to the second location, the pulleys are disposed along the length of the fiber and on alternating sides of the desired fiber (Fig. 3), and the method further comprises moving the second pulley 22 across the path of the fiber to retain the fiber in contact with the first, second, and third pulleys, thereby causing the fiber to move in a serpentine path (Fig. 4).

In regards to claims 49, Bacon as modified by Isoard teaches the aspirator (positioning device) is moved to guide the fiber onto at least one guide pulley 42 by the aspirator (positioning device) guiding the fiber between or against a pair of surfaces 41 which are disposed on each side of the guide pulley, the surfaces sloping toward the guide pulley to thereby guide the fiber onto the guide pulley.

(10) Response to Argument

1. Motivation to Combine

a. Analogous art

The Appellant first contends that there is no motivation to combine the teachings of Bacon and Isoard. The Appellant contends that optical fiber, employed in Bacon, is much stiffer and more brittle than yarn, employed in Isoard, and therefore, concludes that Isoard is not analogous art. The Appellant has provided no basis for this reasoning and provided no evidence to support his conclusion that Bacon and Isoard are not analogous art. Both Bacon and Isoard deal with winding and transferring flexible material. Furthermore, Bacon and Isoard are classified in the same class, 242.

b. Motivation

The Appellant disagrees with the Examiners reasoning for combining the references, to reduce damage to the optical fiber, and contends that the teaching must flow from the prior art and that there is not teaching found in any of the references, thus the Examiner has failed to identify motivation. KSR forecloses the argument that a specific (emphasis added) teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, USPQ2d, slip op. at 20, (BD. Pat. App. & Interf. Hune 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

Bacon discloses an apparatus and method of treading a moving length of optical fiber through a component in optical fiber winding. Isoard teaches transporting a length of flexible material from one position to another using an aspirator. All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time the invention was made.

c. Secondary Considerations

The declaration under 35 USC 1.132 by Kirk Bumgarner has been considered but is unpersuasive. In response to the Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level or ordinary skill at the time the intention was made, and does not include knowledge gleaned only

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from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F. 2d 1992; 170 USPQ 209 (CCPA 1971).

d. Combination of Bacon in view of Isoard results in the Appellant's invention

The Appellant contends that the combination of Bacon in view of Isoard would not result in the claimed invention because the aspirator taught by Isoard is not utilized to thread optical fiber through a component in an optical fiber draw process. The Examiner does not suggest Isoard teaches threading optical fiber, but relies on the teachings of Isoard to show an aspirator used to position an elongated flexible material.

The Appellant further contends that one skilled in the art would not be motivated to use an aspirator as a positioning device in Bacon because Bacon already employs an aspirator for a materially different purpose/function and is located at a different location. The Appellant has not supported this contention with evidence in the record, and the Examiner does not understand the Appellant's reasoning for contending that adding an aspirator as a positioning device would destroy the intended function of the aspirator already in use in Bacon.

The Appellant's last contention is that physically replacing the positioning pin of Bacon with the aspirator of Isoard would not work because the "pressure of the aspirator in Isoard is *likely* (emphasis added) much less than that of the aspirator employed in Bacon" (Br. at 6). First, the Appellant has provided no evidence to support this contention. To the contrary of Appellant's contention, the aspirator 13 of Isoard must be operatively placed near holding aspirator 16 that is used to draw in the flexible material when the material has been broken during operation (aspirator 16 of Isoard performs the same function as aspirator 82 of Bacon),

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then the aspirator 13 must capture the flexible material to position the material from a first to a second position. Second, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (*See In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968)) and skill, rather that the converse is presumed on the part of those of ordinary skill in the art (*See In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985)).

2. Dependant Claims

a. Claim 45

The Appellant has not presented any arguments in the Brief file 16 July 2007 as to the patentability of claim 45.

b. Claims 46-47

The Appellant contends the threading device 91, 92 in Bacon is never utilized to thread the fiber on to the capstan 11. The Examiner does not disagree with this contention, but points to Bacon, col. 9 ll. 4-31 and the abstract ll. 9-15, to show a teaching of the threading device 91, 92 threading the fiber on spools 70, 70' on spindle assemblies 68, 68'. The Appellant further contends that Bacon does not teach automatically threading fiber. First, the limitation 'automatically' is not claimed. Second, Bacon teaches automatically threading, abstract ll. 9-15.

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(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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